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10/806,436

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Takahiro Kaneko

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VIENNA, VA 22182-3817

EXAMINER

GELIN, JEAN ALLAND

ART UNIT

PAPER NUMBER

2617

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/806,436

**Applicant(s)**

KANEKO, TAKAHIRO

**Examiner**

JEAN GELIN

**Art Unit**

2617

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 August 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4 and 7-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 7-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This is in response to the Applicant's arguments and amendments filed on April 18, 2008 in which claim 1 has been amended. Claims 1-4 and 7-28 are currently pending.

#### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 23 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 23, the phrase "detecting, when the prescribed operation has been done, a reception field level of another second communication system than a first communication system that is selected then" is unclear. The definition of the "prescribed operation" is not also clear in the specification. Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-4, 7, 9-14, and 17-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kiyomoto (US 7,003,315) in view of Arimitsu (US 2004/0192224).

Regarding claims 1, 13, 20, 21, 23, and 27, Kiyomoto teaches a wireless communication terminal (dual mode terminal in fig. 2), comprising: an operating unit such as input unit 14, reception field level detecting means for detecting the field level of the received radio wave, a control unit for controlling the terminal (i.e., the terminal detects the received field strength and the control unit compares the RSSI and  $E_c/I_o$  with threshold values  $A_r$  and  $A_e$ , col. 5, line 37 to col. 6, line 5), a storage unit (memory 13), a plurality of wireless communication units each matching a different communication system (i.e., AMPS and CDMA, col. 7, lines 7-30), and switch-over means for switching over one to another of the wireless communication units (i.e., controller 12 includes a system selection control), wherein: the terminal selects one of the communication systems on the basis of the reception threshold field level of a first communication system that is currently selected and that of another second communication system (col. 6, line 35 to col. 7, line 27). Kiyomoto further teaches a prescribed operation used to control the detection of the second system signal strength (i.e., a controller includes a microcomputer to execute programs and perform selection of system having a high priority order of selection in accordance with a list registered beforehand).

Kiyomoto teaches the terminal issues a notice signal when the second communication system has priority and communication with the second communication system is possible.

However, the preceding limitation is known in the art of communications. Arimitsu teaches the mobile terminal decides priorities to be applied to selection of network

systems, the mobile terminal performs switching of the network system from the present network system to new network system designated by the network system being used and thereafter continues communicating operations under control of the new network system. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to implement the technique of Arimitsu within the system of Kiyomoto in order that the mobile terminal can decide when to switch from the present network to a new network system based on strength of signal reception levels provided by other networks.

Regarding claim 2, Kiyomoto in view of Arimitsu teaches all the limitations above. Kiyomoto further teaches the terminal initiates execution detection of the reception of the threshold field level of the second communication system when the reception of the threshold field level of the first communication system that is currently selected has become equal to or below a first threshold (col. 7, lines 7-50).

Regarding claims 3, 4, Kiyomoto in view of Arimitsu teaches all the limitations above. Kiyomoto further teaches the terminal selects the second communication system when the reception of the threshold field level of the first communication system is equal to or below a second threshold that is lower than the first threshold and communication with the second communication system is possible (col. 7, line 45 to col. 8, line 23).

Regarding claim 7, Kiyomoto in view of Arimitsu teaches all the limitations above. Kiyomoto further teaches the terminal selects the second communication system has priority and communication with the second communication system is possible (col. 8, lines 13-54).

Regarding claim 9, Kiyomoto in view of Arimitsu teaches all the limitations above. Kiyomoto further teaches the terminal executes detection of the reception of the threshold field level of the first communication system at prescribed intervals of time (col. 5, line 57 to col. 6, line 25).

Regarding claim 10, Kiyomoto in view of Arimitsu teaches all the limitations above. Kiyomoto further teaches detecting the quality of the signal for for selection of system. Kiyomoto fails to teach a detection unit for detecting a prescribed operation of the terminal wherein: when the prescribed operation is done at the terminal, the terminal executes detection of the reception field level of the second communication system. (col. 5, line 57 to col. 6, line 25, and cos. 7-8).

Regarding claim 11, Kiyomoto in view of Arimitsu teaches all the limitations above. Kiyomoto further teaches the terminal selects the second communication system when communication with the first communication system is impossible and communication with the second communication system is possible (cols. 7-8).

Regarding claim 12, Kiyomoto in view of Arimitsu teaches all the limitations above. Kiyomoto further teaches the terminal determines possibility or impossibility of communication according to a prescribed threshold (col. 5 and cols. 7-8).

Regarding claim 14, 22, and 28, Kiyomoto in view of Arimitsu teaches all the limitations above. Kiyomoto further teaches the terminal selects the second communication system when the second communication system has priority and communication with the second communication system is possible (cols. 7-8).

Regarding claim 16, Kiyomoto in view of Arimitsu teaches all the limitations above. Kiyomoto further teaches the terminal is foldable (typical in conventional cellular phone).

Regarding claims 17, 24, Kiyomoto in view of Arimitsu teaches all the limitations above. Kiyomoto further teaches the prescribed operation is an operation to unfold the terminal (i.e., unfold the cellular phone to receive/transmit a call, typical in conventional phone).

Regarding claims 18, 25, Kiyomoto in view of Arimitsu teaches all the limitations above. Kiyomoto further teaches the prescribed operation is an operation on the operating unit (i.e., dialing a number using the input unit 14).

Regarding claims 19, 26, Kiyomoto in view of Arimitsu teaches all the limitations above. Kiyomoto further teaches a specific key (such power on/off or talk/end call are typical keys for cellular phone illustrated in fig. 2), wherein: the prescribed operation is an operation on the specific key (i.e., pressing the end key).

6. Claims 8 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kiyomoto (US 7,003,315) in view of Arimitsu (US 2004/0192224) further in view of Williams et al. (US 6,363,246).

Regarding claims 8, 15, Kiyomoto in view of Arimitsu teaches a display unit (15) and a speaker unit (10). Kiyomoto with Arimitsu do not specifically teach a notice signal is at least either a display on the display unit or a sound emitted by the speaker unit.

However, the preceding limitation is known in the art of communications. Williams teaches an interface that controls light emitting diodes which are used to

indicate to the user which system the PCC is currently receiving; for example a system identifier may appear in the display of the PCC 101 to indicate the user which system he is in (col. 4, lines 17-39, col. 11, lines 33-44, and col. 12, lines 31-42). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to implement the technique of Williams within the system Kiyomoto with Arimitsu in order that the indication enables the user to determine which system he is in and decide whether he wishes to complete a radiotelephone in the indicated system.

### ***Response to Arguments***

7. Applicant's arguments filed 08/07/08 have been fully considered but they are not persuasive

As per claim 1, the Applicant argues that by detecting reception field levels only when a threshold is reached, battery consumption will be decreased and switchover will be faster due to immediate detection of the threshold. However, the preceding limitation is nowhere to be found in the claim. Therefore, Applicant's argument is not persuasive, and the rejection recited above is maintained.

The Applicant further argues that the claimed invention may switch from one wireless unit to another wireless unit on the basis of the reception field that is currently selected. None of the applied references discloses or suggests the preceding features as described in the independent claims. However, the Examiner disagrees with the preceding arguments. The core of the invention is to select the communication system on the basis of the reception field level. Kiyomoto teaches selecting a system for



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communication based upon priority and reception strength. A threshold value is set to make the comparison and determine the signal quality level to switch from one system to another system (col. 7, line 7 to col. 8, line 23). Kiyomoto further teaches when the terminal is powered on, it selects the system having prior order, if the selected system is deteriorated, it compares signals received from other system with a threshold and selects the system having better quality signal (col. 5, line 17 to col. 6, line 55).

Therefore, the system of Kiyomoto reads on first system is selected, second system has priority, and communication with the second system is possible. But a notification that the second system has priority is not present in Kiyomoto. Arimitsu discloses that the mobile terminal notifies original network system of data about other network systems that provide the signal reception level being higher than a specified level ([0005]) the mobile terminal decides and notifies system's selection ([0045] and [0049]). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to implement the technique of Arimitsu within the system of Kiyomoto in order that the mobile terminal can decides when to switch from the present network to a new network system based on strength of signal reception levels provided by other networks. (see KSR).

The Supreme Court in *KSR* reaffirmed the familiar framework for determining obviousness as set forth in *Graham v. John Deere Co.* (383 U.S. 1, 148 USPQ 459 (1966)), but stated that the Federal Circuit had erred by applying the teaching-suggestion-motivation (TSM) test in an overly rigid and formalistic way. *KSR*, 550 U.S. at \_\_\_, 82 USPQ2d at 1391. Specifically, the Supreme Court stated that the Federal Circuit had erred in four ways: (1) "by holding that courts and patent examiners should

As per claims 8 and 15, the Applicant argues that Williams disclose displaying the system the terminal is currently active but does not overcome the deficiency of Kiyomoto and Arimitsu because there is no suggestion to combine the teaching of Williams with Kiyomoto in view of Arimitsu. However, the Examiner disagrees with preceding assertion. Williams teaches an interface that controls light emitting diodes which are used to indicate to the user which system the PCC is currently receiving; for example a system identifier may appear in the display of the PCC 101 to indicate the user which system he is in (col. 4, lines 17-39, col. 11, lines 33-44, and col. 12, lines 31-42). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to implement the technique of Williams within the system Kiyomoto with Arimitsu in order that the indication enables the user to determine which system he is in and decide whether he wishes to complete a radiotelephone in the indicated system. (See KSR)

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The Applicant further argues that the Examiner makes no attempt to point out specific lines and cols. Location in the prior arts for the rejections claims 20-22. However, the Examiner maintains that the claims are properly rejected as recited above. Claim 20 is the method claim of claim 1. The Examiner does not see any

difference between claim 1 and 20 in terms of claimed invention. Therefore, claims 20-22 are rejected for the same reasons recited above.

As per claim 28, the Applicant further argues that the Examiner attempts to rely upon selection of the system in accordance with a priority listing, the Applicant submits that such an automatic selection fails to satisfy the claim language, since the "prescribed operation" is an event that is involved in automatic selection. However, the Examiner disagrees with the preceding argument because an automatic selection is "prescribed operation". The threshold value is set for the terminal to perform certain operation when the terminal exceeds threshold value. Therefore, the Examiner maintains the previous rejection as recited above and the rejection is final.

### ***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JEAN GELIN whose telephone number is (571)272-7842. The examiner can normally be reached on monday - thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bost Dwayne can be reached on 571 272 7023. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jean A Gelin/  
Primary Examiner, Art Unit 2617  
December 3, 2008